

REMARKS

Claims 66-84 are pending in the application. Reconsideration and allowance of claims 66-84 are respectfully requested.

Prior art rejections

Claims 66-71 and 73-84 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent number 6,421,675 to Ryan, et al. (“Ryan”) in view of U.S. patent number 6,289,341 to Barney (“Barney”). Claims 67, 72-74 and 80-82 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ryan and Barney and further in view of U.S. patent no. 6,078,916 to Culliss (“Culliss”).

The present invention defined by claims 66-84 relates to a method and apparatus for making search term recommendations to an information provider in a computer network search apparatus. In the particular network search apparatus of claim 66, items stored in a database “hav[e] associated with [them] at least one search term, an information provider and a bid amount,” as recited in the preamble of claim 66. Thus, there is an association between the items or search listings and the information provider. The present invention defined by claims 66-83 provides a method and apparatus for recommending search terms to a new information provider, i.e., one who has not previously stored search terms on the database or associated search terms with himself. Because the advertiser or information provider may not know what search terms to specify, or may wish to have a broader range of search terms than he can think up spontaneously, the advertiser may seek recommendations of other search terms. The claimed method and apparatus make search term recommendations based on the contents of the information provider’s own web site and by comparing the advertiser to other similar information providers and recommending search terms they have chosen.

The method acts of claim 66 define how search terms are recommended to one such information provider, particularly a “new information provider” who is establishing search listings on the computer network search apparatus. Generally, according to the method, a set of potential search terms is obtained, computations are done including an estimated rating for each potential new search term, the potential search terms are sorted and presented to the new

information provider who provides an indication of which are accepted search terms. Thus, the claimed method provides a way in which a new information provider can establish search listings in a search system database by making suggestions of possible search terms to the advertiser.

Ryan actually relates to a search system which provides keyword suggestion to a user of the search system. From column 5, line 13, a keyword is “the word or phrase that the user enters to find a list of web pages.” The search process is described at column 4, lines 30-40. The system suggests keywords to the user, based on a keyword that the user entered. Column 7, lines 63-66; column 8, lines 28-32.

Since the keywords are suggested to the user, Ryan fails to disclose the present invention of claims 66-84 which relates to suggesting keywords to an information provider. Information providers are present in the system disclosed by Ryan, e.g., FIG. 1B “Developer site/computer” 104A, B; column 4, lines 3-11. However, Ryan’s keyword suggestion feature serves the user who submits search requests, not the developer who provides content and other information.

Accordingly, Ryan fails to disclose many limitations of the present claims. Ryan is not related to a system and method for suggesting keywords to an information provider and therefore can’t show, describe or suggest the features of the presently claimed invention. For example, claim 66 recites “obtaining a set of potential search terms for acceptance by a new information provider who is adding items to the database.” Ryan does not relate to a new information provider or potential search terms for acceptance by such an information provider. Ryan is instead directed to another party in the search system, the user or searcher. Further, as another example, claim 66 recites “presenting to the new information provider on an output device the sorted potential search terms.” For this limitation, the office action refers to Ryan’s Surfer keyword list at column 8, lines 15-20. However, the Surfer keyword list is described as “a data set comprised of a list of key-words that the individual user found useful after the keyword was selected” (*emphasis added*). Thus, in accordance with the fundamental distinction between Ryan and the presently claimed invention, the Surfer keyword list is a user feature, not a list presented to the new information provider. Ryan just doesn’t relate to the problem solved by the claimed invention.

The office action relies on Barney as disclosing (in claim 66) step (b) “computing correlations.” However, Barney describes a “site examiner” which traverses web sites of others and makes comparisons between web site data and “IP indicia,” or information about an owners intellectual property. The site examiner may user correlations for this comparison. However, Barney does not show or suggest “computing correlations between the potential search terms for the new information provider and search terms of other information providers stored in the database” as recited by claim 66. First, Barney is not related to potential search terms of a new information provider. Second, in the limitation of claim 66, relevant information is stored in “a database” and the correlations are computed on data stored in the database. Barney teaches crawling others’ web sites and performing correlations on the crawled data.

Accordingly, Barney does not provide the missing teaching. Barney is even more remote from the present invention defined by claims 66-84.

Moreover, the keyword suggestion techniques of Ryan, for suggesting keywords to a user or searcher, can not be properly extended to a keyword suggestion device and method for an information provider, such as the method and apparatus in accordance with claims 66-84. The new information provider may not know what search terms to specify, or may wish to have a broader range of search terms than he can think up spontaneously, and therefore the information provider may seek recommendations of other search terms.

In contrast, a user generally seeks a narrower, more focused range of results when he enters a search terms, as Ryan explains at column 1, lines 41-58. Ryan’s device then provides

a method of updating an internet search engine database with the results of a user’s selection of specific web page lists from the general web page listing provided to the user as a result of his initial keyword search entry. *By updating the database with the selections of many different users*, the database can be updated to prioritize those web listings that have been selected the most with respect to a given keyword, and hereby presenting first the most popular web page listings in a subsequent search using the same keyword search entry (*emphasis added*).

Ryan, column 2, lines 27-36.

Accordingly, even though both Ryan and the presently claimed invention broadly provide “keyword suggestion,” it is not proper to extend Ryan’s device to the problem of keyword

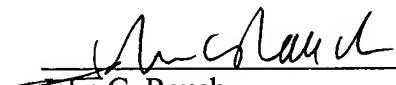
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suggestion for information providers. And even if this extension is made, Ryan simply operates differently to provide keywords to users. The claimed method and apparatus make search term recommendations based on the contents of *the information provider's own web site* and by comparing the advertiser to *other similar information providers* and recommending search terms they have chosen. Ryan is not related to this process. Accordingly, it is submitted that claim 66 is allowable over the cited references.

While only claim 66 has been discussed in detail herein, it is submitted that independent claim 79 includes similar limitations and is allowable for the same reasons. Withdrawal of the rejections of claims 66-84 is respectfully requested.

With this response, the application is believed to be in condition for allowance. Should the examiner deem a telephone conference to be of assistance in advancing the application to allowance, the examiner is invited to call the undersigned attorney at the telephone number below.

Respectfully submitted,


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